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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,822	09/18/2001	Kenneth John Laurence	01831049	3598
26565	7590	11/17/2004		
MAYER, BROWN, ROWE & MAW LLP 190 SOUTH LASALLE ST CHICAGO, IL 60603-3441			EXAMINER SALVATORE, LYNDIA	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

**Office Action Summary****Application No.**

09/955,822

**Applicant(s)**

LAURENCE ET AL.

**Examiner**

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 53-74 and 84-105 is/are pending in the application.
- 4a) Of the above claim(s) 75-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-74, 84-88, 90-97, 102, 103 and 105 is/are rejected.
- 7) ☐ Claim(s) 89, 98-101 and 104 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment and accompanying remarks filed 08/16/04 have been fully considered and entered. Claims 20-42 have been canceled, claims 53,57,58,59,65,69,73,74,84,88,89,96, and 103 have been amended, claims 104 and 105 have been added and claims 75-83 have been withdrawn from consideration as requested. Applicant's cancellation and/or amendment to claims 20, 24, 26, 33, 37, 42, 53, 57, 59, 65, 69, 74, 88, 89, and 103 renders moot and/or obviates the objections set forth in section 2 of the last Office Action. Applicant's amendment to claims 58 and 73 are found sufficient to overcome the 35 U.S.C 112 2<sup>nd</sup> paragraph indefinite rejections set forth in section 3 of the last Office Action. As such, these rejections are withdrawn. Applicant's arguments regarding the anticipation and obviousness type rejections set forth in sections 4-9 are found persuasive. Thus, said rejections are hereby withdrawn. However, double patenting exists with respect to US 6,803,110.

### ***Claim Objections***

2. Claim 105 is objected to because of the following informalities: It appears that the phrase "decorative laminate" is out of place and/or does not belong in claim 105. Appropriate correction is required.

### ***Statutory Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 53-64 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20-31 of prior U.S. Patent No. 6,803,110. This is a double patenting rejection.

37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

#### ***Non-Statutory Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 53-74, and 84-88, 90-97, 102, 103 and 105 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims

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1-42 of U.S. Patent No. 6,803,110. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter present in claims 1-42 of US 6,803,110 substantially encompasses the subject matter of the instant claims. With respect to claims 53-64, it appears that the only difference between claims 1-13 of US 6,803,110 is that independent claim 1 of US 6,803,110 fails to recite a substrate bonded to the decorative laminate top layer assembly, however, as evidenced in independent claim 20 of US 6,803,110, it would be obvious to provide the laminate with a substrate layer. With respect to claims 65-74, it appears the only difference between claims 33-42 of US 6,803,110 and instant independent claim 65 is the recitation of a water resistant adhesive layer. However, instant claim 65 recites bonding the water resistant layer. As such, it is the position of the Examiner that it would be obvious to bond said layer with a water resistant adhesive. With respect to instant claims 84-88, 90-97 and 105, it appears the only difference between claims 14-42 of US 6,803,110 and instant claims 84-88, 90-97, 102,103 and 105 is that independent claims 1,14,20, and 33 of US 6,803,110 are slightly more narrow in scope than instant independent claims 84 and 96.

***Allowable Subject Matter***

7. Claims 89, 98-101, and 104 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claim 89 and 104, the prior art of US 6,803,110 fails to teach employing polycyclohexanedimethyl terephthalate glycol. With regard to claims 98-101, the prior art of US 6,803,110 fails to teach providing the decorative laminate with first and second polyvinylchloride layers

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wherein the second polyvinylchloride sheet is less filled than the first. Presently, there is no motivation to combine references to form an obviousness type rejection.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 3, 2004

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